

Docket No.: RPC 0579 PUS

Serial No. 10/027,741

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICANT: Trenton M Overholt

EXAMINER: Castellano

SERIAL NO.: 10/027,741

GROUP ART UNIT: 3727

FILING DATE: December 20, 2001

FOR: COLLAPSIBLE CONTAINER WITH RECESSED SIDE-PANEL
LATCH

DOCKET NO.: RPC 0579 PUS

PETITION IN RESPONSE TO NOTICE OF NON-COMPLIANCE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellant files this Petition in response to the Notice of Non-Compliance mailed July 21, 2004.

The Notice of Non-Compliance indicates the following bases for rejecting the Appeal Brief:

Item 2: Appellant doesn't specify the claims on appeal.
Item 4: Brief presents the issue of a 112 rejection for claims 9, 12 and 22 where no rejection has been made. Also, all issues are presented in the form of a statement of conclusion rather than as a statement of issue. For example, "whether claim 7 is unpatentable under 35 U.S.C. 112, second paragraph as being indefinite," is a more appropriate manner of stating the issue.
Item 8: The appendix includes claims allowed as well as claims objected to as being dependent on a rejected claim. These claims are not subject to appeal.


On August 23, 2004, Appellant filed a Substitute Brief complying with some of the requests in the Notice of Non-Compliance:

As to Item 2, Appellant added a statement that all of the rejected claims are appealed.

As to the first part of Item 4, Appellant removed arguments relating to a rejection under §112 of claims 9, 12 and 22, since the Examiner clarified that those claims were not rejected under §112. However, additional clarification is requested, as explained below.

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this Petition in Response to Notice of Non-Compliance (5 pages) is being sent via facsimile to 703 872-9306 on September 9, 2004.


Konstantine J. Diamond

In addition to seeking a clarification relating to the first part of Item 4, Appellant requests withdrawal of the objections in the second part of Item 4 and Item 8 (above).

Objection/§112 Rejection of Claims 9, 12 and 22

The Examiner "objected" to claims 9, 12 and 22 saying that the drawings do not show "a raised flange that overlies the outer face of the one side panel when the one side panel is pivoted to the raised position as stated in claims 9, 12 and 22."¹ The Examiner clarified his position by saying that in Appellant's application, "the flange 74 lies adjacent to and in front of the outer face of the side panel rather than above or over."² Thus, the Examiner disagrees with the Appellant's use of the term "overlies" to describe the Appellant's invention, even though this term was in the claims as filed with the application.

In substance, this is not an "objection" to the drawings, but rather a rejection of the claims, which is why Appellant treated it as such in Appellant's original Appeal Brief. Appellant cannot amend the drawings to show the flange 74 "above" the outer face of the side panel, in accordance with the Examiner's interpretation of the claim term "overlies," because in fact, as the Examiner correctly indicates, "the flange 74 lies adjacent to and in front of the outer face of the side panel." The substance of the Examiner's rejection in reality appears to be under §112 first paragraph - - that the specification does not show the Examiner's incorrect interpretation of the "claimed invention," i.e. with the flange "above" the outer face of the side panel.

In any event, Appellant disagrees with the Examiner's interpretation of the claim term "overlies." The term "overlies" is clearly defined in the specification on page 12, lines 7-10:

[O]ther portions 72 of the peripheral edge of the base 12, for example, proximate to the midpoint of each side wall 18, include a raised flange 74 that overlies the side wall's outer face 34 when the side wall 18 is pivoted to the raised position.

The flange 74 is also shown overlying the outer face of the side panel in Figures 1 and 2, reproduced below.

¹ Page 2 of Final Rejection mailed October 24, 2003.

²Id.

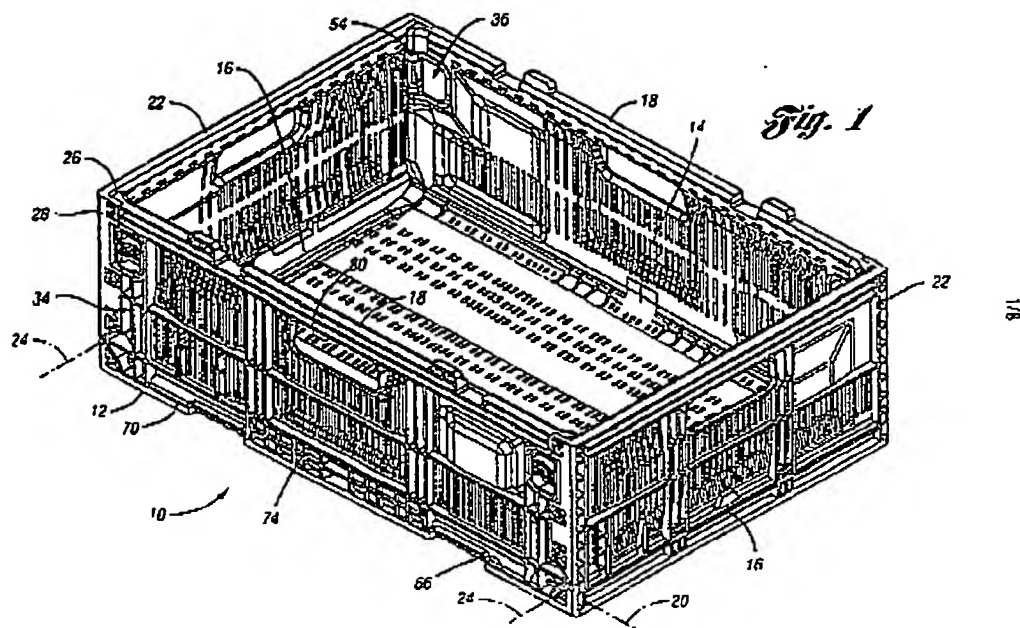


Fig. 1

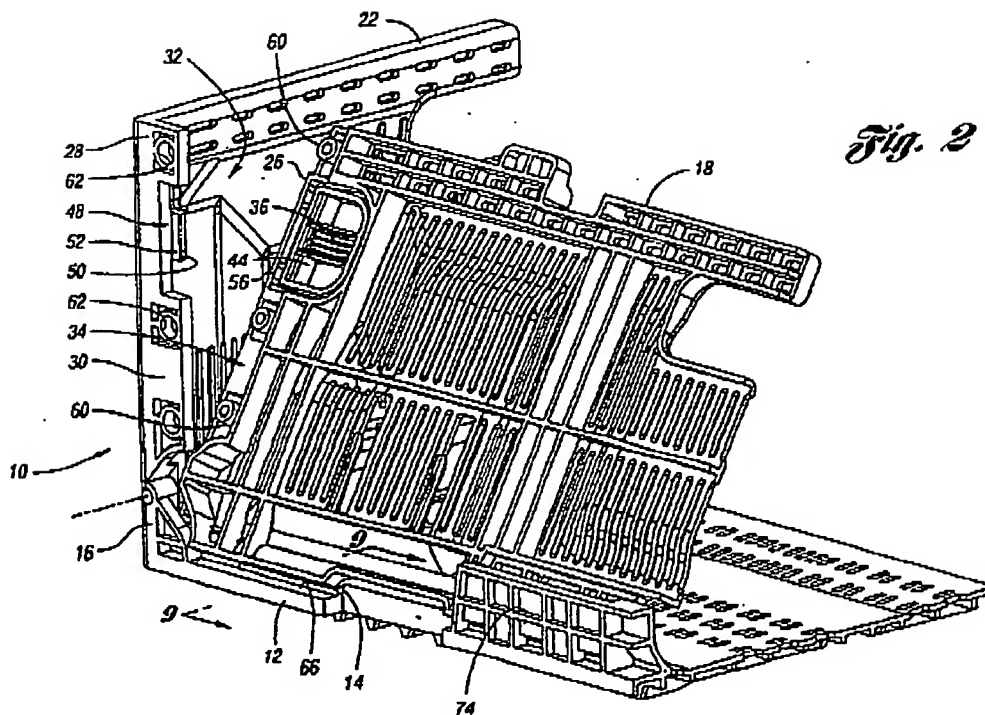


Fig. 2

Therefore, this "objection" is really a "rejection" and should be treated as such. Appellant requests a decision granting the ability to treat this "objection" as a "rejection" in the Appeal Brief. Because Appellant removed this argument from the Substitute Appeal

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Brief filed August 23, 2004 in response to the Notice of Non-Compliance, if this request is granted, Appellant would have to file another Substitute Brief to put this section back.

"The final rejection . . . is improper"

As to the second part of Item 4, Appellant has not modified the Statement of the Issues presented because it has already been determined in the Decision on Petition in U.S. Serial No. 09/921,762 that this objection by this Examiner was incorrect (Decision on Petition, Exhibit A).

Briefly, the Examiner does not like Appellant's phrasing of the Statement of the Issues (e.g., "The final rejection . . . is improper."). The Examiner does not argue that the Statement of the Issues is substantively inaccurate, misleading, or even argumentative. There is currently no specific rule for the format of the Statement of the Issues. Appellant's Statement of the Issues clearly summarizes the issues on appeal and clearly and succinctly states Appellant's position on those issues without arguing those issues. As previously decided, this is not a proper ground for rejecting Appellant's Brief.

Inclusion of Allowed Claims in the Appendix

As to Item 8, Appellant has not modified the Appendix. The Examiner objected to the Appendix because it includes claims that are not being appealed. However, this is not a ground for rejecting the Brief. 37 CFR 1.192(c) "does not prohibit the inclusion of any other material which an appellant may consider necessary or desirable . . ." MPEP 2106. Appellant has submitted what is required. It is not objectionable that Appellant arguably supplied more than what is required. Appellant believes that all pending claims should be included in the appendix, so the Board can compare the rejected and allowed claims and see how certain claim terms have been used in any of the claims, allowed or rejected. This will not be confusing, because the Board will have the "Status of the Claims" section to clearly indicate which claims are allowed and which are rejected.

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No fee should be due. If any additional fees are due, please charge Deposit Account No. 50-1984.

Respectfully submitted,

Dated: September 9, 2004



Konstantine J. Diamond,
Registration No. 39,657
4010 East 26th Street
Los Angeles, California 90023
Telephone: (323) 262-5145
Facsimile: (323) 269-8506